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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,148	09/22/2003	Daniel A. Elefante	2603U.001	4558

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EXAMINER

WEBB, JAMISUE A

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 08/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/671,148	<b>Applicant(s)</b> ELEFANTE, DANIEL A.	
	<b>Examiner</b> Jamisue A. Webb	<b>Art Unit</b> 3629	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 May 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,4-8,11-15,17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-8,11-15,17 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims, 1, 4-8, 11-15, 17 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant has added the claim limitation into the dependent claims where the enclosure includes a camera mounted to provide a view of the counter top, and the camera operatively connected to a visual recording device, where the device making a permanent record of the prohibited items and the instructions for shipment. Previously the applicant has claimed the enclosure includes a camera which makes a permanent record of the prohibited item, but the previous claim never mentioned the visual recording device making a permanent record of the instructions for shipment. The specification talks about the visual recording device making a permanent record of the item and/or the passenger, but never specifically states that the permanent record is of the instructions for shipment. Therefore the limitation of "the visual recording device making a permanent record of .... and said instructions for shipment" is considered to be new matter.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 4-8, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liphard (US 2003/0226883), in view of Gil et al. (US 2002/0007281) and Hansen (US 2002/0156645).

5. With respect to Claims 1 and 11: Liphard discloses the use of a kiosk (1) for use in association with a security checkpoint permitting deposit of prohibited items for shipment to a desired location (See abstract). The kiosk comprising an enclosure adapted to store packaging materials (Reference numeral 11) and labels providing instructions for shipment (Reference numeral 13); Liphard discloses the enclosure having a countertop (Reference numeral 4).

6. Liphard discloses a place for container depository (reference numeral 17) for the passage of items into the enclosure, however fails to disclose the depository being a tamper proof door hinged in said countertop and adapted to permit one-way passage of items into the enclosure. Gil discloses the use of a mailing machine with an automatic door (Paragraph 0072). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Liphard, to include the secure door of Gil, in order to provide increased security for items being mailed (See Gil, Pages 6 and 7).

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7. Liphard and Gil disclose a mailing enclosure for mailing items at a security checkpoint, however fails to disclose the use of a camera, to provide a view of the counter top, and connected to a visual recording device. Hansen, discloses the use of a locker system, which can accept packages, with comprises a camera (15) coupled to recorders, which capture and record images (See Paragraph 0035). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the enclosure of Liphard and Gil, with a camera and recording device, of Hansen, in order to determine if, or verify that an article has been placed into the kiosk. (See Hansen, Page 3).

8. Hansen discloses the permanent record to be of the item, however fails to disclose the permanent record is of the instructions for shipment. However, the specific type of information that is on the permanent record is deemed to be nonfunctional descriptive material and is not functionally involved in the steps recited. The claims do not use the information in the permanent record for any following steps, therefore the recording steps would be performed the same regardless of what type of information is on the permanent record. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F .2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F .3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

9. Liphard also fails to disclose the enclosure includes a microphone connected to an audible recording device. Gil discloses the use of a microphone, in which a voice recognition system for receiving user input (Paragraph 0061), and discloses that the inputs are stored and can be retrieved (See Paragraph 0093), therefore it is the examiner's position that the input is stored, therefore the audible message is stored. It would have

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been obvious to one having ordinary skill in the art at the time the invention was made, to modify Liphard, to include the microphone, with the voice recognition input, in order to provide the ability of system or respond to a user's spoken command (See Gil Page 4).

10. The combination of Liphard, Gil and Hansen discloses the outer door, but discloses the door is on rollers with pulleys and guides (See Paragraph 0072), and fails to expressly disclose the door is hinged to the counter top. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have the door hinged as opposed to on rollers, because Applicant has not discloses that hinging the door provides an advantage, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either the door hinged or on the rollers/pulley system taught by Gil, because both create a secure door that prevents unauthorized users from accessing mail items. Therefore, it would have been an obvious matter of design choice to modify Liphard and Gil, to obtain the invention as specified in Claim 1.

11. With respect to Claim 4: the enclosure is portable (Liphard discloses the system being in the form of a credenza, and does not disclose it is connected or inserted into a wall, therefore the examiner considers this to be portable, Paragraph 0017).

12. With respect to Claim 5: the enclosure is stationary (Liphard discloses the invention can be housed in a wall, therefore the examiner considers this to be stationary, Paragraph 0017).

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13. With respect to Claim 6: the enclosure is connected to a shaft, adapted to pass items for shipment there through (see Figure 2c).

14. With respect to Claim 7: Gill discloses the tamper proof door is connected to a payment device, where operation of the payment device, releases the tamper proof door (See Paragraph 0071 and 0072).

15. With respect to Claims 8: Gil discloses the enclosure includes a safety depository, having reinforced walls, the counter top is reinforced and the tamper proof door accesses the interior of the safety depository (Reference 410, Figure 2b).

16. With respect to Claim 12: Gil discloses the enclosure includes a safety depository, having reinforced walls, the counter top is reinforced and the tamper proof door accesses the interior of the safety depository (Reference 410, Figure 2b).

17. Claims 13 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segrest (US 2003/0191662) in view of Hansen (US 2002/0156645).

18. With respect to Claim 13: A method for mailing back items at a security checkpoint (See abstract, and Figure 3) comprising the steps of:

- a. Providing a kiosk adjacent to a security checkpoint, the kiosk equipped with devices facilitating shipment of the items (mail station, 20);
- b. Using the devices to relate the item with the passenger (Steps 316 and 318);
- c. Using the devices to identify the destination of the item (Step 320 and 328);
- d. Completing a financial transaction for shipping the item (Step 314);

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- e. Preparing the item for shipment (Step 326);
- f. Placing the item in the kiosk (Step 330);
- g. Removing the items from the kiosk and facilitating delivery to the destination (Step 332).

19. Segrest discloses a method for mailing back items at a security checkpoint, however fails to disclose the use of a camera, to provide a view of the counter top, and connected to a visual recording device. Hansen, discloses the use of a locker system, which can accept packages, with comprises a camera (15) coupled to recorders, which capture and record images (See Paragraph 0035). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the enclosure of Liphard and Gil, with a camera and recording device, of Hansen, in order to determine if, or verify that an article has been placed into the kiosk. (See Hansen, Page 3

20. With respect to Claim 18: The method further comprises the steps of:

- h. Providing a security checkpoint manned by security personnel, the security checkpoint having machines to search for prohibited items (300, the examiner considers this to be a security checkpoint, due to the fact that the passenger's baggage is checked, and the passenger is not permitted to proceed until the passenger as well as baggage is searched, see Paragraph 0037);
- i. Detecting at least one prohibited item (Step 306) at a security checkpoint that is manned (Paragraph 0035);
- j. Security personnel taking possession of the item (See Paragraph 0034);
- k. Manning kiosk with personnel (See Paragraph 0035);



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- l. Security personnel delivering prohibited item to kiosk personnel (See Paragraph 0035);

Kiosk personnel taking possession of prohibited item for shipment (See Paragraph 0035).

21. Claims 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Segrest (US 2003/0191662) and Hansen (US 2002/0156645) in view of Liphard (US 2003/0226883).

22. With respect to Claim 14: Segrest, as disclosed above for Claim 13, discloses the use of a method for mailing items back to a passenger, however fails to specifically disclose the specifics of the mailing center (20). Liphard discloses the use of a kiosk used at a security check point, which comprises:

- m. A counter top (4);
- n. A security depository (17);
- o. Providing the counter top with a tamper proof door opening into the depository (See Paragraphs 0025 and 0026).

23. It would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify Segrest, to include the enclosure of Liphard, in order to provide a easy to use secure depository in a pre-screening area, so that a passenger does not have to leave personal items behind on their travels (See Liphard, Page 1).

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24. Claims 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segrest (US 2003/0191662) and Hansen (US 2002/0156645) in view of Gil et al. (US 2002/0007281)

25. With respect to Claim 15: Segrest discloses the use of a mailing system used with a security check point, but is silent as to the features of the mailing station. Gil discloses the use of a mailing center kiosk (100) comprising:

- p. A counter top (See Figure 1a, the examiner considers the top of the kiosk to be a counter top);

- q. A keyboard (See Paragraph 0061);

- r. Where a user inputs instructions to said computer by the keyboard facilitating shipment of the items (See Paragraph 0061).

26. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Segrest to have the mail station be the kiosk of Gil, in order to provide an automated mail processing system which dispenses postage and securely stores items for mailing (See Gil, abstract and Page 3)

27. With respect to Claim 17: Segrest fails to disclose the enclosure includes a microphone connected to an audible recording device. Gil discloses the use of a microphone, in which a voice recognition system for receiving user input (Paragraph 0061), and discloses that the inputs are stored and can be retrieved (See Paragraph 0093), therefore it is the examiner's position that the input is stored, therefore the audible message is stored. It would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify Segrest, to include the microphone, with the

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voice recognition input, in order to provide the ability of system or respond to a user's spoken command (See Gil Page 4)

*Response to Arguments*

28. Applicant's arguments filed 5/30/06 have been fully considered but they are not persuasive.

29. With respect to Applicant's arguments that neither Liphard nor Gill discloses alone or in combination the kiosk with a camera: The rejection has been modified with Hansen to show this feature.

30. With respect to Applicant's challenge of the examiner's statement that it would have been a matter of design choice to have a hinged door as opposed to the door being on rollers: The applicant states that the burden is not on the applicant to submit this proof, but the burden is on the examiner to show that the hinged doors are equivalent to and function the same as doors on rollers. The examiner has stated in the obvious design choice rejection, that the doors provide the same outcome, whether a door is on a hinge or on rollers it still provides a door which has an opening, then allows for the door to be closed to close off the opening. The door being on rollers would have performed equally as well a door being on hinged, due to the fact that the applicant has not stated that there is an advantage, purpose or solution of the hinged door. The examiner has presented a clear line of reasoning on how the hinged door and door on rollers are equivalent, due to the fact that they perform the same outcome, therefore the examiner considers the line of reasoning to be sufficient burden to show the hinged door is an obvious matter of design choice. The applicant has challenged the statement, however the burden is on the

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applicant to point out the errors in the rejection. Where as the burden is not on the applicant to show proof that the door are equivalent in the art, the burden is on the applicant to dispute the rejection, and to point out how they are not equivalent or obvious design structures over the other. Rejection stands as sated above.

31. With respect to Applicant's arguments that Hansen does not disclose making a video recording of the instructions for shipping the items: As stated above, this limitation is considered to be new matter, due to the fact that the original specification discloses making a recording of the item and passenger, but never the instructions for shipping. Furthermore, due to the fact that the instructions are not used further in the claims, the content of what is actually being recorded is considered to be non-functional data. Rejection stands as stated above.

32. With respect to Applicant's request to submit evidence to support the official notice that was taken in the non-final rejection: The applicant replies on MPEP 2144.03 and states that the examiner must supply evidence. However, 2144.03 states

“the examiner should not be obliged to spend time to produce documentary proof. If the knowledge is of such notorious character that official notice can be taken, it is sufficient to state so.”

33. A “traverse” is a denial of an opposing party's allegations of fact. The Examiner respectfully submits that applicants' arguments and comments do not appear to traverse what Examiner regards as knowledge that would have been generally available to one of ordinary skill in the art at the time the invention was made. Even if one were to interpret applicants' arguments and comments as constituting a traverse, applicants' arguments and comments do not appear to constitute an adequate traverse because applicant has not

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specifically pointed out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. 27 CFR 1.104(d)(2), MPEP 707.07(a). An adequate traverse must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying Examiner's notice of what is well known to one of ordinary skill in the art. In re Boon, 439 F.2d 724, 728, 169 USPQ 231, 234 (CCPA1971).

34. Applicant has not submitted any rebuttal of the well known limitations, but merely requested proof that the statements are well known. MPEP 2144.03 states that the applicant must be given the opportunity to challenge the correctness of such assertions and allegations.” Again, the applicant has not challenged the correctness of the assertions, only the use of Official Notice. Bald statements such as “If this is true then the examiner is requested to submit evidence to support this statement as required by 2144.03 MPEP”, is not adequate and does not shift the burden to the examiner to provide evidence in support of the Official notice. Allowing such statements to challenge Official Notice would effectively destroy any incentive on the part of the examiner to use it in the process of establishing a rejection notoriously well known facts (*In re Boon*, 169 USPQ 231 (CCPA 1971)). Rejection stands as stated above.

### ***Conclusion***

35. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

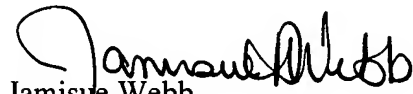
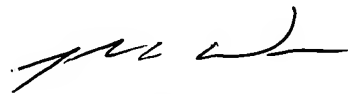
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Webb whose telephone number is (571) 272-6811. The examiner can normally be reached on M-F (7:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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